

REMARKS

Claim 18 has been amended. Claims 18, 20-23 and 28 are still pending.

1. Obviousness-Type Double Patenting

Claims 18, 20-23 and 28 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of U.S. Patent Nos. 6,604,537, 6,209,557, 5,778,915, 5,579,799, 5,560,385 and 6,851,439. In response, even though Applicant does not agree with these rejections, Applicant will submit a terminal disclaimer for U.S. Patent Nos. 6,604,537, 6,209,557, 5,778,915 and 6,851,439 after the other substantive rejections have been overcome. However, Applicant respectfully traverses the obviousness-type double patenting rejection based on U.S. Patent Nos. 5,579,799 ("the '799 patent") and 5,560,385 ("the '385 patent") as follows.

First, page 800-21 of the August 2005 revision of the MPEP states that:

"[a] double patenting rejection of the obviousness-type is 'analogous to [a failure to meet] the obviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination."

As a result, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) are employed, and "are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of a patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art;
and
- (D) Evaluate any objective indicia of nonobviousness."

That same page of the MPEP goes on to state that "[a]ny obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent."

Finally, page 800-28 of the August 2005 revision of the MPEP states that:
"... a double patenting rejection must rely on a comparison with the claims in an issued ... patent ...".

Applicant respectfully submits that an obviousness-type double patenting rejection of independent claim 18 based on the '799 and '385 patents cannot be sustained if the above-quoted principles are applied. On pages 3-4 of the Office Action, the Examiner points out the **similarities** between claim 18 and the claims of the '799 and '385 patents. However, as pointed out below, the Examiner fails to identify the numerous **differences** between claim 18 and the claims of the '799 and '385 patents (as required by the MPEP). In addition, the Examiner has failed to provide reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in the claims of the '799 and '385 patents.

a. USP 5,579,799

Following the guidelines outlined in the MPEP, it is necessary to first identify the differences between the inventions defined by claims 1 and 9 of the '799 patent compared to claim 18 of the present application.

In this regard, claims 1 and 9 of the '799 patent recite a collapsible structure having at least **three side** panels that are **connected via adjacent sides** to form an enclosed interior space. In contrast, claim 18 of the present application only recites **two** members (or panels).

In addition, claim 18 recites the following limitations that are different from (or not found in) claims 1 and 9 of the '799 patent:

- i. a collapsible structure having a side member **connected at its bottom side** to a first side of a **base** member;

- ii. **flat** members;
- iii. the base member rests on a surface when the structure is in the deployed configuration; and
- iv. the base member and the side member are connected to each other at an **acute angle**.

Claims 1 and 9 of the '799 patent are silent about flat panels and base panels, and are also silent about any connections at an acute angle. In addition, claim 18 of the present application does not recite the enclosing of any interior space.

Thus, there are numerous differences between claims 1 and 9 of the '799 patent and claim 18 of the present application.

Continuing to apply the guidelines outlined in the MPEP, it is then necessary to explain why a person of ordinary skill in the art would conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claims 1 and 9 of the '799 patent. Here, the person of ordinary skill in the art would need to find it obvious to convert a collapsible structure having at least **three side** panels that are **connected via adjacent sides**, into a structure having (i) a base member and a side member that are connected to each other at an **acute angle**, and (ii) with the base member resting on a surface when the structure is in the deployed configuration. Applicant respectfully submits that these two contrasting structures are so different that the only way for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claims 1 and 9 of the '799 patent would have been through the use of impermissible hindsight reconstruction. The numerous differences (as identified above) make it impossible for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claims 1 and 9 of the '799 patent.

b. USP 5,560,385

Following the guidelines outlined in the MPEP, it is necessary to first identify the differences between the inventions defined by claim 1 of the '385 patent compared to claim 18 of the present application.

Claim 1 of the '385 patent recites a collapsible structure having at least three **side** panels that are **connected via adjacent left and right sides**, with each side panel having a **square** configuration, and **each side panel having a bottom side that is**

adapted to rest on a surface to support the structure. In contrast, claim 18 of the present application only recites **two** members (or panels) that are not even connected to each other along their left and right sides.

Claim 18 also recites the following limitations that are different from (or not found in) claim 1 of the '385 patent:

- i. a collapsible structure having a side member **connected at its bottom side** to a first side of a **base** member;
- ii. **flat** members;
- iii. the base member rests on a surface when the structure is in the deployed configuration; and
- iv. the base member and the side member are connected to each other at an **acute angle**.

In addition, claim 18 of the present application does not provide a bottom side for each side panel that rests on a surface to support the structure. Claim 1 of the '385 patent is silent about flat panels and base panels, and is also silent about any connections at an acute angle. In addition, claim 18 of the present application does not recite square panels or members.

Thus, there are numerous differences between claim 1 of the '385 patent and claim 18 of the present application.

Continuing to apply the guidelines outlined in the MPEP, it is then necessary to explain why a person of ordinary skill in the art would conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claim 1 of the '385 patent. Here, the person of ordinary skill in the art would need to find it obvious to convert a collapsible structure having at least three **side** panels that are **connected via adjacent left and right sides**, with each side panel having a **square** configuration, into a structure having (i) a base member and a side member that are connected to each other at an **acute angle**, and (ii) with the base member resting on a surface when the structure is in the deployed configuration. Applicant respectfully submits that these two contrasting structures are so different that the only way for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claim 1 of the '385 patent would have been through the use of impermissible hindsight reconstruction. The numerous differences (as identified above) make it impossible for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claim

1 of the '385 patent.

c. Response to the Examiner's Arguments

Applicant responds to the Examiner's arguments on pages 6 and 7 of the Final Office Action as follows:

The Examiner asserts that the claimed structure of claim 18 ("Claimed Structure") can be obtained by re-positioning (i.e., re-orienting) the structures recited in the claims of the '799 and '385 patents. However, the structures recited in the claims of the '799 and '385 patents are so different from the Claimed Structure that even re-orienting or re-positioning them will not yield the same structures. In particular, as pointed out above, the structures recited in the '799 and '385 patents all require at least three side panels (as opposed to two members in the Claimed Structure). Therefore, even if one of the panels in the structures of the '799 and '385 patent are placed on a floor, there will be at least two additional panels. In contrast, the Claimed Structure would only have one member in addition to the base member. On this basis alone, it is clear that re-positioning the '799 Structure and the '385 Structure will not yield the Claimed Structure.

The Examiner asserts that it is irrelevant that some of the cited reference claims contain additional limitations. However, Applicant disagrees with this contention because these additional limitations clearly evidence the differences between the Claimed Structure and the structures recited in the '799 and '385 patents. As set forth above, the MPEP requires that the "differences between the inventions defined by the conflicting claims" be considered and compared. Thus, the existence of these additional limitations in the claims of the '799 and '385 patents is significant in evidencing the non-obviousness of the Claimed Structure over the structures recited in the '799 and '385 patents.

* * *

Thus, claim 18 of the present application is quite different, and patentably distinct, from the claims of the '799 and '385 patents. Claim 18 of the present application recites a structure that is both different, and patentably distinct, from the structures recited in the claims of the '799 and '385 patents, because the respective structures are based on a different number of basic panels (two versus at least three). There are many other limitations (see (i)-(iv) above) that are present in claim 18 that are not present in the claims of the '799 and '385 patents. There are also many limitations (see above) that are present in the claims of the '799 and '385 patents that are not found in (and which are irrelevant to) claim 18. Thus, Applicant respectfully submits that it would not be obvious

to modify the claims in the '799 and '385 patents to include these limitations.

In light of the above reasons, withdrawal of the obviousness-type double patenting rejection based on the '799 patent and the '385 patent is respectfully requested.

2. USP 5,249,592 to Springer et al. ("Springer") in view of 5,411,046 to Wan ("Wan")

Claims 18, 20-23 and 28 stand rejected under 35 USC 103(a) as being unpatentable over Springer in view of Wan. This rejection is respectfully traversed.

First, the Examiner acknowledges that Springer does not disclose sleeves for retaining the frame members. However, Applicant asserts that Springer also does not disclose a separate piece of fabric for each frame member. Claim 18 has been amended to further clarify, and to highlight, this distinction.

In particular, Springer discloses a single fabric material that covers the bands 32 and 34. Since there are no sleeves in the Springer structure, the fabric material must be draped over the bands 32 and 34. Column 3, line 55 to column 4, line 5 of Springer's specification supports this interpretation. Thus, Springer does not disclose a separate piece of fabric for each frame member.

Applicant acknowledges that Wan discloses the provision of sleeves for its frame members. However, Applicant asserts that the structures in Springer and Wan are based upon such different underlying construction that a person skilled in the art would not find it obvious to modify Springer in the manner suggested by the Examiner.

In particular, Springer wraps a fabric around an enclosed space defined by two bands 32, 34 that are connected by spring connectors 36. In contrast, Wan provides separate panels that are hingedly connected to each other, with each panel having its own fabric and sleeve. Thus, the underlying construction of the Springer and Wan structures are very different. A person of ordinary skill in this art who begins with Springer would have to make two significant changes to (i) the fabric structure and (ii) the connection. Why would this skilled person want to do this? What incentive exists for this skilled person to change these two significant aspects of the construction? Thus, any attempt to combine Springer and Wan would be the result of impermissible hindsight reconstruction.

In light of the above, it is respectfully submitted that all pending claims are in condition for allowance. The Examiner is encouraged to phone the undersigned if the Examiner has any amendments or suggestions for putting this application in condition for allowance.

Respectfully Submitted,



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CERTIFICATE OF MAILING

I hereby certify that this paper and its enclosures are being deposited with the United States Postal service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Date: May 4, 2006

By: 
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